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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/737,234	12/14/2000	James R. Moran	12598.0128.NPUS00 SOLU:12	8345
7590	12/22/2003		EXAMINER	
Craig M. Lundell, Esq. HOWREY, SIMON, ARNOLD & WHITE, LLP PO Box 4433 Houston, TX 77210-4433			FERGUSON, LAWRENCE D	
			ART UNIT	PAPER NUMBER
			1774	

DATE MAILED: 12/22/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	Application No. 09/737,234	Applicant(s) MORAN ET AL.
	Examiner	Art Unit
	Lawrence D Ferguson	1774

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### **Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

1)  Responsive to communication(s) filed on 20 October 2003.

2a)  This action is **FINAL**.                            2b)  This action is non-final.

3)  Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## **Disposition of Claims**

4)  Claim(s) 1-6,9,10,12 and 14-24 is/are pending in the application.  
4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.

5)  Claim(s) \_\_\_\_\_ is/are allowed.

6)  Claim(s) 1-6,9,10,12 and 14-24 is/are rejected.

7)  Claim(s) \_\_\_\_\_ is/are objected to.

8)  Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

9)  The specification is objected to by the Examiner.

10)  The drawing(s) filed on \_\_\_\_\_ is/are: a)  accepted or b)  objected to by the Examiner.

    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)  The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. §§ 119 and 120**

12)  Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a)  All b)  Some \* c)  None of:  
1.  Certified copies of the priority documents have been received.  
2.  Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3.  Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\* See the attached detailed Office action for a list of the certified copies not received.

13)  Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.  
a)  The translation of the foreign language provisional application has been received.

14)  Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

**Attachment(s)**

1)  Notice of References Cited (PTO-892) 4)  Interview Summary (PTO-413) Paper No(s). \_\_\_\_ .  
2)  Notice of Draftsperson's Patent Drawing Review (PTO-948) 5)  Notice of Informal Patent Application (PTO-152)  
3)  Information Disclosure Statement(s) (PTO-1449) Paper No(s) 6)  Other: \_\_\_\_ .

**DETAILED ACTION**

***Response to Amendment***

1. This action is in response to the amendment mailed October 20, 2003.

Claims 8, 13 and 25 were canceled rendering claims 1-6, 9-10, 12 and 14-24 pending.

***Double Patenting***

2. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1, 3-4, 6, 12, 14-15 and 24 provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-2, 5-7, 9-10, 13 and 15-16 of copending Application No. 09/962750. Although the conflicting claims are not identical, they are not patentably distinct from each other because both applications include a composite laminate interlayer for a glass laminate comprising a sheet of polyethylene terephthalate between two layers of plasticized polyvinyl butyral, wherein each plasticized polyvinyl butyral layer is between about

10-80 mils and the polyvinyl butyral has a glass transition temperature greater than at least 35°C.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

***Claim Rejections – 35 USC § 103(a)***

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 1-6, 9-10, 12 and 14-24 are rejected under 35 U.S.C. 103(a) as being unpatentable over Moran (U.S. 5,091,258).

Moran discloses a composite laminate comprising polyvinyl butyral layers (14 and 16) and a polyethylene terephthalate (PET) interlayer (12) having a functional coating layer (18) (column 4, lines 29-57, claim 4 and Figure 1). Moran discloses glass sheets (9, 11) where the optional coating of interlayer (12) reflects radiation (column 3, lines 54-65). Moran does not disclose the claimed thickness of the PVB layers and PET interlayer as in instant claims 1-4, 6, 9 and 15. The experimental modification of this prior art in order to achieve optimum operating conditions fails to render applicants' claims patentable in the absence of unexpected results. *In re Aller* USPQ 233. On of ordinary skill in the art would have been motivated to adjust the thickness of the PVB layers and PET layer in order to optimize the resilience of the laminate interlayer. (See

*In re Boesch and Slaney*, 205 USPQ 215). Although the reference does not teach a temperature transition, maximum load or maximum flex modulus, it would have been obvious to one of ordinary skill in the art to include these features because Moran teaches the same materials having the same function as applicants claimed invention. With respect to the claimed temperature transition, maximum load and maximum flex modulus of the composite laminate, these features are directly related to the specific plasticized material used. Since the reference uses the same polyvinyl butyral and PET layers as claimed by applicant, the temperature transition, maximum load and maximum flex modulus of the glass laminate would be expected to be the same as Applicant claims.

#### ***Response to Arguments***

5. Applicant's remarks to rejection made under 35 USC 103(a) as being unpatentable over Benson, Jr. et al (U.S. 5,796,055) in view of Frost et al. (U.S. 5,932,329) have been considered moot based on grounds of new rejection.

#### ***Conclusion***

6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Lawrence Ferguson whose telephone number is (703) 305-9978. The examiner can normally be reached on Monday through Friday 8:30 AM – 4:30PM. If attempts to reach the examiner by telephone are unsuccessful, the

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examiner's supervisor, Cynthia Kelly can be reached on (703) 308-0449. Please allow the examiner twenty-four hours to return your call.

The fax phone numbers for the organization where this application or proceeding is assigned are (703) 872-9310 for regular communications and (703) 872-9311 for After Final communications. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-2351.



Lawrence D. Ferguson  
Examiner  
Art Unit 1774

